

REMARKS/ARGUMENTS

Applicants have carefully reviewed the Office Action mailed January 11, 2008, prior to preparing this response. Claims 3-11 and 13-20 were pending in the application, wherein claims 3-11 and 13-20 have been rejected. Claims 3, 9, 10 and 19 have been amended, claim 20 has been cancelled, and claim 21 has been added with this paper. Support for the amendments may be found, for example, at lines 20-22 of page 3, lines 12-26 of page 4, and lines 19-21 of page 5. The current pending claims, after the amendments listed above, are claims 3-11, 13-19, and 21. No new matter has been added. Favorable consideration of the above amendments and following remarks is respectfully requested.

Claim Rejections under 35 U.S.C §103

Claims 3 and 7-9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hunter et al. (U.S. Patent No. 6,071,030) in view of Truc et al. (U.S. Patent No. 4,911,777). Applicants respectfully traverse this rejection.

Claim 3, as currently amended, recites:

A method comprising:

providing an assembly of a blank sheet and a hinge strip, the hinge strip including a mounting strip having a plurality of mounting holes therein and first and second connecting strips, the first and second connecting strips formed of a dissimilar material from the mounting strip, wherein the first connecting strip is a separate component from the second connecting strip, the mounting strip spaced apart by a gap from the edge of the blank sheet, the first connecting strip having a first end portion adhesively attached to a first side of the mounting strip and having a second end portion adhesively attached to the blank sheet along a first side of the blank sheet and spanning the gap between the mounting strip and the blank sheet, and the second connecting strip having a first end portion adhesively attached to a second side of the mounting strip and having a second end portion adhesively attached to the blank sheet along a second side of the blank sheet and spanning the gap between the mounting strip and the blank sheet;

sending the assembly through a printer to print a photographic image on the blank sheet; and

mounting the assembly in an album using the mounting strip.

Claim 3, has been amended to indicate that the first connecting strip is a separate component from the second connecting strip, and that end portions of each connecting strip

are adhesively attached to the mounting strip and the blank sheet, spanning the gap between the mounting strip and the blank sheet.

Applicants assert the cited references do not seem to teach at least these limitations of claim 3. In formulating the rejection, it appears as though the flaps 52 of the mounting member 46 of Truc et al. are being equated to the claimed connecting strips. Applicants respectfully note that as shown in FIG. 6 of Truc et al. the mounting member 46 is folded around the hanger 48 and the flaps 52 are adhesively attached to the sheet of sleeving material 12, but not adhesively attached to the hanger 48. Thus, the flaps 52 are portions of a continuous member which is folded around the hanger 48. When the sheet 12 is hanging in a vertical file, forces between the mounting member 46 and the hanger 48 are transmitted through the doubled over portion of the mounting member 46 in contact with the hanger 48. If the mounting member 46 were made of two separate components, there would be no doubled-over portion to which forces could be transferred through.

Notwithstanding the amendments to claim 3, claim 3 is believed patentable over the cited rejection. In formulating the rejection of claim 3, the Examiner asserts that “[i]t would have been obvious...to modify the assembly of Hunter et al. to have the gap and connecting strips, as taught by Truc et al.” Applicant respectfully disagrees with this suggestion.

Hunter teaches a divider sheet that can be printed on by sending the divider sheet through a printer. See Hunter, at column 1, lines 15-21. Hunter states that “common printers and copiers may have a thickness restriction as well as a width restriction, due to interior clearances and due to the radii of bends in the sheet path through those machines.” See Hunter, at column 1, lines 49-52. In view of the limitations of printers and copiers, the teachings of Hunter are “directed to remedying the problems in and limitations of the prior art” by providing a tabbed binder sheet which can be fed through a printer without jamming. See Hunter, at column 3, lines 1-17.

The divider sheet may include a binding edge region 114 which is formed integral with the page. See Hunter, at column 6, lines 52-62. Thus, the binding edge region 114 is a continuation of the main body portion 116 of the divider, forming a unitary divider sheet.

Hunter clearly distinguishes the binding edge region 114 taught in Hunter from prior art approaches of adhering a pre-punched spine strip along the edge of a sheet after the sheet

has been sent through a printer. See Hunter, at column 1, lines 33-35. In teaching away from such an approach, Hunter indicates several disadvantages of the prior art assemblies. See Hunter, at column 1, lines 33-47. Thus, Hunter clearly teaches away from the use of pre-punched spine strips that are adhered to a page after printing on the page.

Hunter teaches that with the folding portion 120 of the binding edge region 114 folded over and adhesively tacked to the non-folding portion 124 of the binding edge region 114, "the assembly 110 is ready to be fed into a laser printer, ink-jet printer or photocopier." See Hunter, column 7, at lines 26-30. Hunter stresses the importance that when the folding portion 120 is folded over, "the total thickness of the folded-over portion is approximately the same as the thickness of the main body of the sheet." See Hunter, at column 7, lines 50-54. Because the folded-over portion is approximately the same thickness as the main body portion, the sheet "will pass through the printer without jamming." See Hunter, at column 7, lines 40-41.

In looking at FIG. 6 of Truc, it is clear that if the hanging file mount shown in FIG. 6 were attached to the divider of Hunter, the divider would no longer be capable of being sent through a printer without jamming. Hunter indicates the thickness of a single sheet of paper stock which the divider sheet is formed of would be approximately 6.5 to 8.0 mil thick. See Hunter, at column 8, line 2. The hanging file mount 44 of Truc would have a thickness much greater than the thickness of a single sheet divider of Hunter. Thus, the divider would have an uneven thickness which would prevent proper feeding of the divider through a printer.

Furthermore, it is noted that claim 3 includes the step of sending the assembly (Note, as claimed, the assembly includes the blank sheet, the mounting strip and first and second connecting strips) through a printer. In formulating the rejection of claim 3, it is noted that the Examiner is equating the hanger 48 of Truc to the claimed mounting strip. Truc teaches that the hanger 48 is a commercially available hanger which is "generally formed from lightweight metal." See Truc, at column 4, lines 4-5. One of skill in the art would understand that a metal hanger as taught in Truc could not be sent through a printer. Namely, Hunter teaches that the sheet path through printers includes bends through which the sheet must be subjected to. See Hunter, at column 1, lines 49-52. The metal hanger 48 of Truc would not be able to pass through the radii of bends in the sheet path necessary for the assembly to be

sent through a printer. Claim 3 states that the assembly, including the blank sheet and the mounting strip is sent through a printer. In order to meet the limitations of claim 3, the formulation of the rejection would necessarily require the hanger 48 of Truc to be sent through a printer, a step clearly not possible in view of the teachings of Hunter.

Thus, Hunter seems to teach away from any type of binding region that is thicker than the divider sheet, and clearly teaches away from some spine strip attached to the divider sheet after the sheet has been sent through a printer. The Manual of Patent Examining Procedure instructs that “[i]t is improper to combine references where the references teach away from their combination.” M.P.E.P. §2145 X D, citing *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). The Supreme Court has recently reaffirmed that when the prior art teaches away from a suggested direction of analysis, a finding of nonobviousness can be ascertained. See *KSR Int’l Co. v. Teleflex Inc.*, 127 US 1727, 82 USPQ2d 1385 (2007). The teachings of Hunter clearly preclude a finding of obviousness in the instant case.

Furthermore, a *prima facie* case of obviousness cannot be established if the proposed modification renders the prior art unsatisfactory for its intended purpose or changes the principle of operation of a reference. See 2143.01. Applicant respectfully asserts that, as indicated above, modifying the divider of Hunter with the mounting taught in Truc would render the divider of Hunter unsatisfactory for its intended purpose of being able to be fed through a printer without jamming. Namely, the metal hanger 48 would preclude the divider from being able to be sent through a printer.

Furthermore, claim 3 includes the step of “mounting the assembly in an album using the mounting strip.” Truc teaches slide storage files formed of sheets of slide sleeving material to which a hanging file or ring binder storage mount can be attached. See Truc, at column 2, lines 11-14. Truc teaches a hanging file mount at FIGS. 5 and 6, and Truc teaches a ring binder mount at FIGS. 7 and 8. The hanging storage file mount 44 shown in FIGS. 5 and 6, the components of which are relied on in meeting the mounting strip and first and second connecting strips of the hinge strip as claimed in claim 3, is not intended to be mounted in an album. Instead, one of ordinary skill in the art would understand that the hanging storage file mount 44 shown at FIGS. 5 and 6 of Truc is configured to allow the sleeve sheet 12 to hang in a vertical file like a hanging file. See Truc, at column 3, line 64

through column 4, line 16. The only embodiment disclosed for mounting the sleeve sheet 12 in an album or binder is shown at FIGS. 7 and 8. However, Applicant asserts this embodiment does not teach the limitations recited in claim 3.

Thus, the teachings of Hunter, combined with those of Truc, do not seem to suggest an assembly as claimed which can be sent through a printer, and then mounting the assembly in an album using the mounting strip of the assembly. For at least these reasons, a *prima facie* case of obviousness has not been established. Withdrawal of the rejection is respectfully requested.

For at least the reasons stated above, claims 7-9, which depend from claim 3 and include additional limitations, are also believed to be in condition for allowance. Withdrawal of the rejection is respectfully requested.

Furthermore, claim 9, which depends from claim 3, recites mounting the assembly in an album includes using the mounting holes. In formulating the rejection, the Examiner states that "the primary reference Hunter et al. teaches mounting holes 122." However, in formulating the rejection of claim 3, it is noted that the Examiner is equating the hanger 48 to the claimed mounting strip. The hanger 48 does not include mounting holes as currently claimed. Instead, as shown at FIG. 5 of Truc, the hanger is a metal bar having hooks at either end which are configured to rest on rails of a hanging file drawer. One of skill in the art would understand that such a hanging file hanger would not include mounting holes. There is no teaching or motivation to add mounting holes to the hanger 48 taught at FIG. 5 of Truc. One of skill in the art, wanting to mount a page in a binder, would use the ring binder storage mount 60 shown in FIG. 7 of Truc. However, Applicant asserts this embodiment shown at FIG. 7 of Truc does not teach the limitations recited in claim 9.

For at least this reason, as well as the reasons stated above regarding claim 3, a *prima facie* case of obviousness has not been established. Withdrawal of the rejection is respectfully requested.

Claims 4 and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hunter et al. (U.S. Patent No. 6,071,030) in view of Truc et al. (U.S. Patent No. 4,911,777) as applied to claims 3 and 7-9 above, and further in view of Tyler (U.S. Patent No. 4,207,366). Claims 4 and 6 depend from claim 3. For at least the reasons stated above, a *prima facie* case

of obviousness has not been established for claim 3, in view of the teachings of Hunter and Truc. The Tyler reference, which apparently is relied upon only to provide particulars of the type of paper used, fails to remedy the shortcomings of Hunter and Truc. Applicant believes that the above remarks indicate that a *prima facie* case of unpatentability does not exist, and the rejection of claims 4 and 6 should to withdrawn.

Claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hunter et al. (U.S. Patent No. 6,071,030) in view of Truc et al. (U.S. Patent No. 4,911,777) as applied to claims 3 and 7-9 above, and further in view of Singh et al. (U.S. Patent No. 6,332,953). Claim 5 depends from claim 3. For at least the reasons stated above, a *prima facie* case of obviousness has not been established for claim 3, in view of the teachings of Hunter and Truc. The Singh reference, which apparently is relied upon only to provide particulars of the type of paper used, fails to remedy the shortcomings of Hunter and Truc. Applicant believes that the above remarks indicate that a *prima facie* case of unpatentability does not exist, and the rejection of claim 5 should to withdrawn.

Claims 10-11 and 15-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hunter et al. (U.S. Patent No. 6,071,030) in view of Truc et al. (U.S. Patent No. 4,911,777) and Emmel et al. (U.S. Patent No. 5,683,194).

Claim 10 recites:

A method of providing a ready-to-bind photo sheet, the method comprising:

providing an assembly of a blank photo-printable sheet and a hinge strip spaced apart by a gap from an edge of the blank photo-printable sheet and connected by connecting strips thereto, the connecting strips formed of a flexible polymeric film, the hinge strip including a mounting portion including a plurality of mounting holes for mounting the hinge strip to an album, the mounting portion formed of a paper material, wherein the assembly is dimensioned to go through a desktop printer; and

sending the assembly through a feed mechanism of a desktop printer to print a photographic image upon the sheet;

wherein the mounting portion and the connecting strips are flexible such that the mounting portion and the connecting strips do not disrupt the step of sending the assembly through the feed mechanism of the desktop printer.

In formulating the rejection, it appears as though the binding edge region 114 taught in Hunter is being equated to the claimed hinge strip. As discussed above, the divider sheet of

Hunter may include a binding edge region 114 which is formed integral with the page. See Hunter, at column 6, lines 52-62. Thus, the binding edge region 114 is a continuation of the main body portion 116 of the divider, forming a unitary divider sheet. Hunter clearly distinguishes the binding edge region 114 taught in Hunter from prior art approaches of adhering a pre-punched spine strip along the edge of a sheet after the sheet has been sent through a printer. See Hunter, at column 1, lines 33-35.

With the binding edge region 114 formed integral with the main body portion 116 of the divider, by definition there can be no gap between the binding edge region 114 and the main body portion 116. Thus, there would be no need for connecting strips to connect the binding edge region 114 to the main body portion 116. Furthermore, as indicated above, Hunter teaches away from adding non-uniform thickness to the divider page. Using connecting strips to connect the binding edge region 114 to the main body portion 116 would necessarily add non-uniform thickness to the divider sheet, making the divider sheet prone to jamming and skewing in the printer. In view of the teachings of Hunter, one of skill in the art would not be inclined to add connecting strips as suggested in the rejection.

Furthermore, Applicant respectfully traverses the Examiner's suggestion that "Truc et al. teaches an assembly for mounting in an album" at FIGS. 5 and 6. Truc teaches slide storage files formed of sheets of slide sleeving material to which a hanging file or ring binder storage mount can be attached. See Truc, at column 2, lines 11-14. As discussed above, the embodiment shown at FIGS. 5 and 6 of Truc is a hanging storage file mount to allow the sleeve sheet 12 to hang in a vertical file like a hanging file. The only embodiment disclosed for mounting the sleeve sheet 12 in an album or binder is shown at FIGS. 7 and 8. However, Applicant asserts this embodiment does not teach the limitations recited in claim 10, and is not relied upon by the Examiner in formulating the rejection.

Moreover, claim 10 has been amended to indicate that the mounting portion is formed of a paper material, and the mounting portion and the connecting strips are flexible such that the mounting portion and the connecting strips do not disrupt the step of sending the assembly through the feed mechanism of the desktop printer. Applicant asserts that the hanging storage file mount disclosed at FIGS. 5 and 6 of Truc are not able to be sent through the feed mechanism of a desktop printer without jamming. Namely, the hanger 48 of the hanging

storage file mount of Truc, is made of metal and would not be able to pass through the radii of bends in the sheet path necessary for the assembly to be sent through a printer.

Thus, the teachings of Hunter, combined with those of Truc and Emmel, do not seem to suggest an assembly as claimed which can be sent through a printer. For at least these reasons, a *prima facie* case of obviousness has not been established. Withdrawal of the rejection is respectfully requested.

For at least the reasons stated above, claims 11 and 15-18, which depend from claim 10 and include additional limitations, are also believed to be in condition for allowance. Withdrawal of the rejection is respectfully requested.

Furthermore, claim 11 includes the step of "binding the assembly in an album using the mounting portion of the hinge strip." Truc teaches slide storage files formed of sheets of slide sleeving material to which a hanging file or ring binder storage mount can be attached. See Truc, at column 2, lines 11-14. Truc teaches a hanging file mount at FIGS. 5 and 6, and Truc teaches a ring binder mount at FIGS. 7 and 8. The hanging storage file mount 44 shown in FIGS. 5 and 6, the components of which are relied on in meeting the hinge strip and first and second connecting strips as claimed in claim 10, is not intended to be mounted in an album. Instead, one of ordinary skill in the art would understand that the hanging storage file mount 44 shown at FIGS. 5 and 6 of Truc is configured to allow the sleeve sheet 12 to hang in a vertical file like a hanging file. See Truc, at column 3, line 64 through column 4, line 16. The only embodiment disclosed for mounting the sleeve sheet 12 in an album or binder is shown at FIGS. 7 and 8. However, Applicant asserts this embodiment does not teach the limitations recited in claim 10.

Applicant asserts the cited prior art does not teach a ready-to-bind photo sheet with the limitations as claimed in claim 10, which is sent through a desktop printer and then bound in an album using the mounting portion of the hinge strip. As a *prima facie* case of obviousness has not been established, withdrawal of the rejection is respectfully requested.

Claim 19 recites:

A method of providing a ready-to-bind photo sheet, the method comprising:
providing a blank photo-grade sheet, a mounting strip, a first connecting strip formed of a first strip of flexible polymeric film, and a second connecting strip formed of a second strip of flexible polymeric film discontinuous from the first strip of flexible polymeric film, the mounting

strip formed of a dissimilar material from the first and second connecting strips;

positioning the mounting strip along an edge of the blank sheet and spaced apart by a gap from the edge of the blank sheet, the mounting strip including a plurality of mounting holes for mounting the assembly in a photo album, and

adhesively attaching the first connecting strip formed of a flexible polymeric film along a first side of the blank sheet;

adhesively attaching the first connecting strip to the mounting strip along a first side of the mounting strip, such that the first connecting strip spans the gap between the mounting strip and the blank sheet;

adhesively attaching the second connecting strip formed of a flexible polymeric film along a second side of the blank sheet; and

adhesively attaching the second connecting strip to the mounting strip along a second side of the mounting strip, such that the second connecting strip spans the gap between the mounting strip and the blank sheet.

Applicant respectfully traverses the assertions made in the Office Action regarding the teachings of Hunter, Truc and Emmel as meeting the claimed limitations of claim 19. It is unclear from the rejection what element the Examiner is relying on as teaching the claimed mounting strip. It appears as though it is either the folding portion 120 of the binding edge region 114 of Hunter or the hanger 48 of the hanging storage file mount 44 of Truc. Applicant asserts that neither would establish a *prima facie* case of obviousness.

As discussed above, the binding edge region 114 taught in Hunter is formed integral with the main body portion 116 of the divider. By definition there can be no gap between the binding edge region 114 and the main body portion 116. Thus, there would be no need for connecting strips to connect the binding edge region 114 to the main body portion 116.

Alternatively, if the hanger 48 of the hanging storage file mount 44 of Truc is equated to the claimed mounting strip, Applicant asserts that the hanger 48 does not include a plurality of mounting holes as recited in claim 19. Instead, as shown at FIG. 5 of Truc, the hanger is a metal bar having hooks at either end which are configured to rest on rails of a hanging file drawer. One of skill in the art would understand that such a hanging file hanger would not include mounting holes. There is no teaching or motivation to add mounting holes to the hanger 48 taught at FIG. 5 of Truc. One of skill in the art, wanting to mount a page in a binder, would use the ring binder storage mount 60 shown in FIG. 7 of Truc. However,

Applicant asserts this embodiment shown at FIG. 7 of Truc does not teach the limitations recited in claim 9.

Additionally, claim 19 has been amended to recite that the first connecting strip is formed of a first strip of flexible polymeric film and the second connecting strip is formed of a second strip of flexible polymeric film discontinuous from the first strip of flexible polymeric film. Applicants assert that the cited references do not seem to teach two discontinuous flexible polymeric film connecting strips spanning the gap between a mounting strip and a blank sheet on opposing sides of the blank sheet.

Furthermore, “[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” M.P.E.P. §2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In formulating the rejection, the Examiner admits that the cited prior art “does not explicitly teach attaching the first connecting strip to the mounting strip adhesively.” Thus, it appears as though the Examiner is taking official notice that “it would have been obvious to apply the adhesive attachment method of the connecting strip and the blank sheet to attaching the connecting strip and the mounting strip in order to provide a more flexible method of attachment.” Applicant respectfully traverses this position.

The Manual of Patent Examining Procedure expressly states that “[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. M.P.E.P. §2144.03 A.

The hanger 48 shown in FIG. 6 of Truc is enclosed by the mounting member 46. As such, when the hanger 48 is hanging on the rails of a vertical file drawer, the mounting member 46 is draped over the hanger 48. Thus, forces between the mounting member 46 and the hanger 48 are transmitted through the doubled over portion of the mounting member 46 in contact with the hanger 48. Thus, adhering the mounting member 46 to the hanger 48 would not provide any perceived advantage to the functionality of the hanging file mount 44.

Applicant respectfully requests that if the rejection is to be maintained, the Examiner must provide documentary evidence in the next Office Action in support of the Examiner’s suggested motivation. See M.P.E.P. §2144.03. It is noted that “[t]he examiner bears the

initial burden of factually supporting any *prima facie* conclusion of obviousness.” M.P.E.P. §2142.

Claims 13 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hunter et al. (U.S. Patent No. 6,071,030) in view of Truc et al. (U.S. Patent No. 4,911,777) and Emmel et al. (U.S. Patent No. 5,683,194) as applied to claims 10-11 and 15-20 above, and further in view of Tyler (U.S. Patent No. 4,207,366).

Claims 13 and 14 depend from claim 10. For at least the reasons stated above, a *prima facie* case of obviousness has not been established for claim 10, in view of the teachings of Hunter, Truc and Emmel. The Tyler reference, which apparently is relied upon only to provide particulars of the type of paper used, fails to remedy the shortcomings of Hunter, Truc and Emmel. Applicant believes that the above remarks indicate that a *prima facie* case of unpatentability does not exist, and the rejection of claims 13 and 14 should be withdrawn.

Newly Added Claim 21

Claim 21 has been added with this paper. Applicants assert the cited prior art does not teach the method recited in claim 21. For example, the cited prior art does not teach a roll of blank photo-grade paper, a first roll of adhesive tape, a second roll of adhesive tape, and a roll of board material; positioning a layer of the roll of paper board material along an edge of a layer of the blank photo-grade paper and spaced apart by a gap from the edge of the layer of the roll of blank photo-grade paper; adhesively attaching the layers of the rolls of adhesive tape along opposing sides of the layer of the blank photo-grade paper; and adhesively attaching the layers of the rolls of adhesive tape along opposing sides of the layer of the roll of paper board material, such that the layers of the rolls of adhesive tape span the gap between the layer of the roll of paper board material and the layer of the roll of blank photo-grade paper. Favorable consideration of claim 21 is respectfully requested.

Conclusion

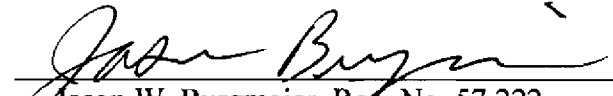
Reexamination and reconsideration are respectfully requested. It is respectfully submitted that the claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By his attorney,

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